

ATTY. DOCKET NO.: P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: :
: Marcus HARTMANN et al. :
: Serial No.: 09/914,870 :
: Filed: September 4, 2001 :
: For: B-HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM :
CILIATES AND USE THEREOF :
METHOD :

RESPONSE TO NOTICE TO COMPLY WITH SEQUENCE RULES

Commissioner of Patents
Box PCT
Washington, D.C. 20231

Sir:

In accordance with the Notice to Comply with sequence rules 37 CFR 1.821 – 1.825, a copy of which is attached, hereto, applicant submits, herewith:

- (1) Computer Readable Form (CRF) of Sequence Listing; and
- (2) Substitute paper copy of Sequence Listing.

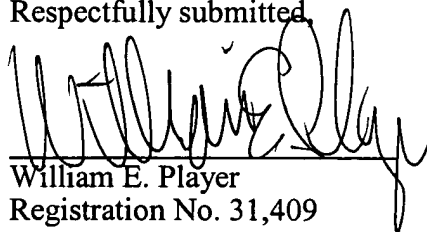
The content of the computer readable form and the paper copy are the same and, where applicable, include no new matter, as required by 37 CFR § 1.821(e), § 1.821(f), § 1.821(g), § 1.825(b), or 1.825(d).

An amendment entering the Sequence Listing is filed, concurrently herewith.

Favorable action is requested.

Respectfully submitted,

By


William E. Player
Registration No. 31,409

JACOBSON HOLMAN PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
Telephone: (202) 638-6666
Atty. Docket No.: P67083US0
Date: January 28, 2002
WEP:rdt

2/11-01
TC 11-1-01

christ

PG 7083 USG
Page 1 of 2

☒ Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D.C. 20231, www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/914,870	Marcus HARTMANN	P67083US0

00136
JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

COPY

JACOBSON HOLMAN PLLC
Response Due On Or Before
12 / 26 / 01
Month Day Year

INTERNATIONAL APPLICATION NO.

PCT/EP00/01853

IA. FILING DATE

03/03/2000

PRIORITY DATE

03/04/1999

CONFIRMATION NO. 4106

371 FORMALITIES LETTER



OC000000006962386

Date Mailed: 10/26/2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Indication of Small Entity Status
- Priority Document
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Preliminary Amendments
- Request for Immediate Examination

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):
 - A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
 - APPLICANT MUST PROVIDE:
 - An initial or substitute computer readable form (CRF) of the "Sequence Listing."
 - A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:
 - For Rules Interpretation, call (703) 308-4216
 - To Purchase PatentIn Software, call (703) 306-2600
 - For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

FRANCINE YOUNG

Telephone: (703) 305-3662

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/914,870	PCT/EP00/01853	P67083US0



JC10 Rec'd PCT/PTO 28 JAN 2002 PCT #

Atty. Docket No. P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Marcus HARTMANN et al.

Serial No.: 09/914,870

Filed: September 4, 2001

For: β -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM CILIATES AND USE THEREOF

TRANSMITTAL

Commissioner of Patents
Box PCT
Washington, D.C. 20231

Sir:

Transmitted herewith are:

- Copy of Notification of Missing Requirements mailed October 26, 2001.
- Declaration of inventors under 37 CFR 1.497.
- Response to Notice to Comply with Sequence Rules, including Sequence Listing, Amendment, and computer diskette.
- Petition for Extension of Time.
- Statement Under 37 CFR 1.497(d)(1).
- Consent of Assignee Under 37 CFR 1.497(d)(3).
- Check in the amount of \$185 for: extension of time; processing fee as required under 37 CFR 1.497(d)(2).

If a Petition for Extension of Time is necessary and the Petition and/or the check is not enclosed, this will act as the Petition and applicant herewith petitions the Commissioner to extend the time for response and charge any fees necessary under 37 CFR 1.17 (a)-(d) to Deposit Account No. 06-1358. The Commissioner is also authorized to charge payment of any other additional fees associated with this communication or credit any overpayment to Deposit Account No. 06-1358.

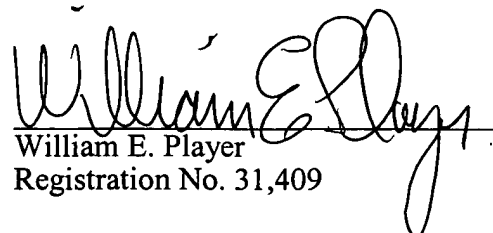
02/04/2002 UEDUVIJE 00000026 09914870

01 FC:122

130.00 OP

JACOBSON-HOLMAN PLLC
400 Seventh Street, N. W.
Washington, D.C. 20004-2201
Date: January 28, 2002
WEP:rdt
R:\HOME\thomas\2002\January\P67083trn.wpd

By:


William E. Player
Registration No. 31,409

Atty. Docket No. P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Marcus HARTMANN et al.

Serial No.: 09/914,870

Filed: September 4, 2001

For: β -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM
CILIATES AND USE THEREOF

STATEMENT UNDER 37 CFR 1.497(d)(1)

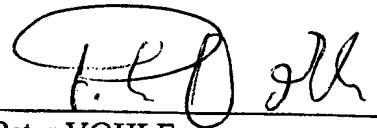
Commissioner of Patents
Washington, D.C. 20231

Sir:

Peter VOHLE, a citizen of Germany, states that any error in inventorship in international application PCT/EP00/01853, filed March 3, 2000, occurred without deceptive intention on his part.

10.01.2002

Date



Peter VOHLE

BEST AVAILABLE COPY

Atty. Docket No. P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Via Facsimile

Marcus HARTMANN et al.

703-305-3230

Serial No.: 09/914,870

Filed: September 4, 2001

For: β -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM
CILATES AND USE THEREOF

TRANSMITTAL

Commissioner For Patents
Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

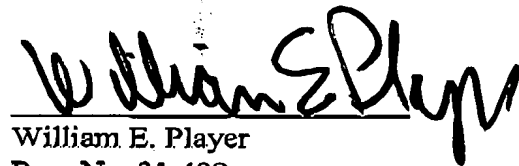
Transmitted herewith via facsimile are Response to the Notification of Defective Response,
together with a copy of the Notification, mailed May 14, 2002..

Should any Government fees be required in conjunction with the transmitted Response,
please charge the fees necessary to Deposit Account No. 06-1358. Petition is made for any extension
of time necessary in conjunction with this response is.

Respectfully submitted,

JACOBSON-HOLMAN PLLC

By:


William E. Player
Reg. No. 31,409400 Seventh Street, N.W.
The Jenifer Building
Washington, D.C. 20004
Tel.: (202) 638-6666
Atty. Dkt. No.: P67083US0
Date: June 14, 2002
R:\HOME\thomas\2002\June\P67083tm.wpd

P 67083450

WEP



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT
 United States Patent and Trademark Office
 Washington, D.C. 20231
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/914,870	Marcus HARTMANN	P67083US0

 00136
 JACOBSON HOLMAN PLLC
 400 SEVENTH STREET N.W.
 SUITE 600
 WASHINGTON, DC 20004

COPY

INTERNATIONAL APPLICATION NO.	
PCT/EP00/01853	
LA. FILING DATE	PRIORITY DATE
03/03/2000	03/04/1999

 JACOBSON HOLMAN PLLC
 Response Due On Or Before
 6 / 14 / 02
 Month Day Year

 CONFIRMATION NO. 4106
 371 FORMALITIES LETTER

OC00000008097553

Date Mailed: 05/14/2002

NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fee
- Indication of Small Entity Status
- Priority Document
- Assignee Statement
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - Is not executed by inventor Vohle

Applicant is required to complete the response within a time limit of **ONE MONTH** from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

BEST AVAILABLE COPY

*A copy of this notice **MUST** be returned with the response.*

FRANCINE YOUNG

Telephone: (703) 305-3662

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/914,870	PCT/EP00/01853	P67083US0

FORM PCT/DO/EO/916 (371 Formalities Notice)

BEST AVAILABLE COPY

BEST AVAILABLE COPY

Atty. Docket No. P67083US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Marcus HARTMANN et al.

Serial No.: 09/914,870

Filed: September 4, 2001

For: β -HEXOSAMINIDASE AND A DNA SEQUENCE CODING IT OBTAINED FROM
CILIATES AND USE THEREOF**RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE**Commissioner For Patents
Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

According to the Notification of Defective Response mailed May 14, 2002 (copy submitted herewith), the inventorship declaration of record allegedly fails to comply with 37 CFR 1.497(a) "in that it: Is not executed by inventor Vohle." As a result of the allegation, the Notification requires a new oath or declaration of inventorship be furnished to the PTO. The requirement for a new oath or declaration is improper and unnecessary.

A new oath or declaration need not be furnished because the inventorship declaration of record, in fact, *does comply* with 37 CFR 1.497(a), allegations in the Notification to the contrary notwithstanding.

In the instant national stage application, the inventorship declaration of record does not name Peter Vohle, who is named as an inventor in the international application, i.e., PCT/EP00/01853, filed March 3, 2000. This situation is governed by 37 CFR 1.497(d), which reads in pertinent part (*emphasis added*):

BEST AVAILABLE COPY

Atty. Docket No. P67083US0
Serial No.: 09/914,870

§1.497 Oath or declaration under 35 U.S.C.

371(c)(4) . . .

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section *names an inventive entity different from the inventive entity set forth in the international application* . . . applicant must submit:

(1) A statement from each person being added as an inventor and from *each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;*

(2) The processing fee set forth in §1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee

In accordance with 37 CFR 1.497(d), besides the inventorship declaration of record, the papers filed January 28, 2002, in response to the notification of missing requirements mailed October 26, 2001, included:

- 1) "Statement Under 37 CFR 1.497(d)(1)," executed by Peter Vohle, which reads (*emphasis added*):

Peter VOHLE, a citizen of Germany, states that *any error in inventorship in international application PCT/EP00/01853, filed March 3, 2000, occurred without deceptive intention on his part;*

- 2) A check covering *the processing fee set forth in §1.17(i);* and
- 3) "Consent Of Assignee Under 37 CFR 1.497(d)(3)," executed by assignee Cilian AG, which reads:

Cilian AG, a corporation of Germany, assignee of the instant application . . . consents in accordance with 37 CFR 1.497(d)(3) to

BEST AVAILABLE COPY Atty. Docket No. P67083US0
Serial No.: 09/914,870

the filing, herewith, of the inventorship declaration under 35 USC 371(c)(4) and 37 CFR 1.497, which inventorship declaration names an inventive entity different from the inventive entity set forth in international application PCT/EP00/01853, filed March 3, 2000.

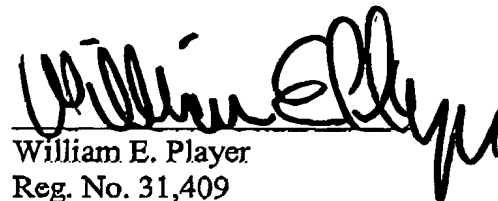
Accordingly, compliance with 37 CFR 1.497(a) is met by the inventorship declaration of record, which "names an inventive entity different from the inventive entity set forth in the international application," since the declaration was filed together with the papers and fee required in accordance with 37 CFR 1.497(d).

Favorable action is requested.

Respectfully submitted,

JACOBSON-HOLMAN PLLC

By:


William E. Player
Reg. No. 31,409

400 Seventh Street, N.W.
The Jenifer Building
Washington, D.C. 20004
Tel.: (202) 638-6666
Atty. Dkt. No.: P67083US0
Date: June 14, 2002

RAHOME\thomas\2002\June\P67083rsp\nt\dfcrsp.wpd

*** RX REPORT ***

RECEPTION OK

TX/RX NO	8906	
CONNECTION TEL		202 393 5350
SUBADDRESS		
CONNECTION ID		
ST. TIME	06/14 19:45	
USAGE T	02'26	
PGS.	6	
RESULT	OK	